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05 MAR 1998

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Paper No. 13

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Valley Dental, Inc.

Sam S

Serial No. 74/651,842

with 12/19/77

Paul Grandinetti of Cammarata & Grandinetti for Valley Dental, Inc.

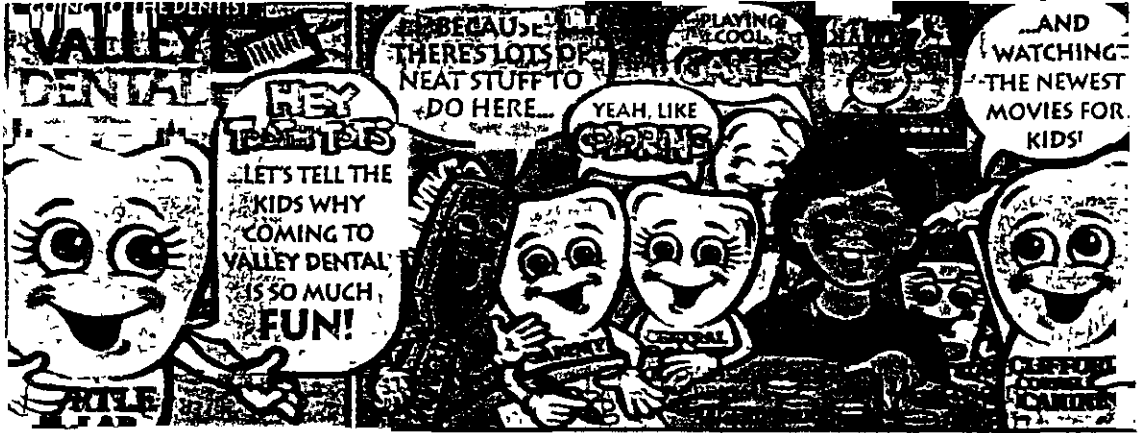
Dominic J. Salemi, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Cissel, Seeherman and Hanak, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

The above-identified application was filed on March 27, 1995, seeking registration on the Principal Register of the mark "TOMMY TOOTHBRUSH" as a service mark for "promoting dental services and dental health," in Class 42. Applicant claimed first use and use in interstate commerce since January 4, 1988, and stated that the mark is used "by printing it on signs, brochures, booklets, letterhead, labels, bulk mail, novelty items, and custom printed products[,] by broadcasting on radio and television, and by other ways customary in the trade." The

application included as specimens photocopies of the cartoon shown below.



Note that the mark which is sought to be registered by means of this application, "TOMMY TOOTHBRUSH," does not appear anywhere on the specimen. The toothbrush-shaped cartoon character to the left of the center is labeled "TOMM," but that is as close as the specimen submitted with the application gets to showing the mark applicant claims to have used.

The Examining Attorney found the specimens to be unacceptable as evidence of service mark use of the term sought to be registered because "they contain no reference to a service." The Examining Attorney cited Trademark Rule 2.58 and required specimens which showed the term sought to be registered used to identify the services set forth in the application. Additionally, the original recitation of services was found to be indefinite, so amendment to the recitation was required. The Examining Attorney suggested adoption of "promoting dental

services and dental health through (explain method e.g. through personal visits by a costumed character."

Applicant responded by amending the application to restate the services as "promoting dental services and dental health through informative promotions, in Class 42." Applicant offered the following explanation of how the mark is used in connection with its services: "The applicant promotes its dental services and dental health through informative promotional material that is oriented to children. The promotions are signs, brochures, and advertisements and include characters in stories and/or cartoons that promote good dental practices."

Submitted with this explanation were eighteen declarations from applicant's customers. In each, the declarant avers that he or she is familiar with applicant's advertisements for its services of promoting dental health and dental services, as well as a number of the marks applicant seeks to register in connection with the same services. Each declarant further asserts that he or she has come to associate the services provided by applicant with the specified marks, including the mark "TOMMY TOOTHBRUSH."

The Examining Attorney made the requirement for substitute specimens final with the second Office Action. Applicant was again advised that "three specimens showing the mark as it is used in commerce" were required. Again the Examining Attorney required amendment to the recitation of services because the

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existing one was found to be indefinite, and again he suggested adoption of "promoting dental services and dental health through personal visits by a costumed character."

On December 20, 1996, applicant appealed. Submitted with the notice of appeal was an amendment to the recitation of services. The application was amended to specify the services as "promoting dental health to children."

Also included were substitute specimens, supported by a proper declaration from applicant's vice president as to use at least as early as the filing date of the application. The specimens are copies of pages from a brochure which applicant states is given to children as part of the service of promoting dental health to them.

The first page appears to be the cover for the brochure. It bears the title "The Adventures of Myrtle Molar and the Tooth Tots." A tooth-shaped cartoon character is shown holding a membership card for "The Tooth Tots Club." She is saying "Hey Kids! Join the Tooth Tots Club today." The design of a personified toothbrush labeled "Tommy" is also shown. Next to him are the words, "You'll get free gifts, free games, and unlimited fun!" Applicant's name, "Valley Dental," is shown with a toothbrush design at the bottom of this sheet.

The second page of the brochure features more information on the Tooth Tots Club and how to join it. Children and tooth-shaped cartoon characters are depicted, along with a man who

invites the children to join the club. The third page shows more tooth characters and gives still more information, including addresses and telephone numbers for applicant's offices, a certificate for free membership in the Tooth Tots Club, and a free dental examination.

The final sheet appears to be the outer cover of applicant's brochure. It features some of the cartoon tooth characters, applicant's name and return address, and an indication that applicant has already paid the postage.

None of the last three pages of the brochure shows the tooth character labeled "TOMMY" on the first page, and nowhere in any of the specimens submitted, either the originals or the substitutes subsequently submitted, is the entire mark sought to be registered, "TOMMY TOOTHBRUSH," shown.

On March 12, 1997, the Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for consideration of the amendment and substitute specimens.

On April 22, 1997, the Examining Attorney responded by accepting the amendment to the recitation of services, but maintained the requirement for specimens showing the mark used to identify the services set forth in the application, as amended. He pointed out that none of the specimens showed the term "TOMMY TOOTHBRUSH."

The application file was returned to the Board for resumption of action on the appeal. On February 18, 1997, however, applicant had filed its appeal brief, but the brief had not been matched with the file until after the Examining Attorney had already reconsidered the requirements based on the amendment and specimens submitted by applicant with the notice of appeal. Unaware that the Examining Attorney had pointed out that none of the specimens actually showed the mark, applicant's brief mistakenly states that "the specimens bear the mark TOMMY TOOTHBRUSH with various characters holding toothbrushes." Further, applicant mistakenly states that the amendment to the recitation of services was not accepted by the Examining Attorney. Applicant's brief goes on to present extended arguments in support of its contentions that the specimens show the mark used to identify the services of promoting dental health to children.

The Examining Attorney filed his responsive brief on November 7, 1997. In it, he mischaracterizes the issue on appeal as whether the Board should affirm the refusal to register under Sections 2, 3 and 45 of the Act because "TOMMY TOOTHBRUSH" does not function as a mark. Registration had never been refused on that basis, however. Notwithstanding his conclusion in his response to applicant's request for reconsideration that none of the specimens shows the mark, he argues in his brief that "specimens, like applicant's in this case, which show an alleged

mark but which make no reference to the services offered or performed thereunder is (sic) not evidence of service mark use." At another point in his brief, however, he does reiterate the fact that none of the specimens in this application even show the mark sought to be registered.

Applicant did not file a reply brief, and no oral hearing was requested, so this appeal is ripe for resolution.

The apparent inconsistencies in both applicant's arguments and the arguments of the Examining Attorney may be because counsel for applicant had a number of concurrently-filed applications from the same applicant pending before the same Examining Attorney wherein the issues included whether the recitation of services was indefinite and whether the specimens showing the various marks showed a direct association between those marks and the services set forth in those applications. As is sometimes the case in such situations, all these applications were treated similarly by both applicant and the Examining Attorney, even if the circumstances did not warrant it.

Notwithstanding the confusion apparent in the correspondence between applicant and the Examining Attorney, the issue in this appeal is clearly not the acceptability of the amended recitation of services, nor is it the propriety of a refusal to register under Sections 2, 3 and 45 of the Act. In his Office Action of April 22, 1997, the Examining Attorney specifically accepted the

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amendment to the recitation of services. Registration has never been refused under Sections 2, 3 and 45.

The issue before us on appeal is the acceptability of the specimens. From the very first Office Action, the Examining Attorney has required specimens which show the mark used in the sale or advertising of the services. Although most of the discussion between the Examining Attorney and counsel for applicant has centered around whether the specimens must refer specifically to applicant's service, the fact remains that the Examining Attorney consistently repeated the requirement for specimens which showed the mark sought to be registered used in commerce to identify applicant's services.

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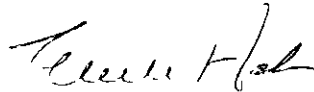
As we noted repeatedly above, none of the specimens, either the originals or the subsequently submitted ones, shows the mark, so none meets the requirement of Section 1(a)(1)(C) of the Lanham Act for "specimens or facsimiles of the mark as used " Accordingly, the requirement for specimens which show the mark used to identify applicant's services is affirmed.



R. F. Cissel



E. J. Seeherman



E. W. Hanak

Administrative Trademark Judges,
Trademark Trial & Appeal Board

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